

Mailroom date
9/3/03

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August 28, 2003

Re: Application No. 10/031,776 - request for reconsideration

Dear Alex P. Rada,

I would like to request that you reconsider the rejection of claim 1 of application 10/031,776, because I believe the classification of lines 12-23 of claim 1 is wrong. I discuss this fully below, and then deal with the points you raised individually.

I attach amended claims, in which I cancel claim 2-7, leaving only Claim 1. I marked claim 1 as original, because it is the same as the one I attached when entering the national phase, though different from the one in the international application.

I also attach abstract as requested, and a proposal for an additional figure to correct the drawing.

Classification of the lines 12-23 of Claim 1: In the last paragraph of section 9 of the detailed action (p.6 second paragraph), it says:

"In regard to the claimed rules in claim 1, a line 12-23, this statement is considered a game rule.

I believe this is wrong. What lines 12-23 describe is the behaviour of the board, not game rules. Game rules are instructions to people ('players') what they are supposed to do and what they should try to achieve when playing the game. For example, "three cards face up, two cards face down" is an instruction to the player that puts the cards how he should put them. For the game which is described in this application, the game rules would be something like:

Select one of the colours.

When the turn light of your colour is on, touch an unilluminated point, trying to find a point that will become illuminated.

The players don't need to know anything more than that, because the board itself will do the right thing, i.e. illuminate the point if the move is legal (This simplicity, coupled with the considerable strategic depth of the game, is the main attraction of the game, and the board in general).

Lines 12-23 of claim 1 do not contain any instructions to the players, and hence they are not game rules. (Claim 1 in the international application did contain one line that could be interpreted as such instruction, but you should have the amended claims which I attached when entering the national phase, where I corrected this). They are a description of the behaviour of the grid board, and this behaviour exists independently of the game. This point

can be proved by an experiment in which a grid board with the described behaviour is given to a scientist who is asked to determine how the board behaves. By touching points and observing the responses of the board, the scientist will be able to work out the rules of behaviour as described in Claim 1, even if he didn't figure out that it is supposed to be used for playing a game. An alternative experiment would be to give the board and the description to somebody and ask them to test if the board complies with the description. The tester would be able to determine whether the board complies or not just by touching points and observing responses, without playing the game.

Thus the behaviour has a physical existence which is independent of the game, in the sense that it can be detected and tested independently of the game.

The behaviour which is described in lines 12-23 is also novel and non-obvious, and therefore it is patentable, and hence claim 1 is patentable.

The behaviour is non-obvious as long as the game is unknown, but that indeed was the case prior to the disclosure of the first priority document of this application (GB 9919551.3). That means that the inventive step contained designing the game, but as far as I know that is not an obstacle for patenting, provided that what is actually claimed is not itself game rules.

Specific points in the detailed action:

Drawing: Since I cancelled claims 2 and 4, these are not relevant anymore. As far as claim 1 is concerned, figures 4 and 5 illustrate the imaginary lines emanating from the point. The algorithm that is described in claim 1 doesn't easily admit an illustration, because there is no clear way to indicate looping through all the imaginary lines. I am attaching a proposal for another figure, Fig 6, which illustrates the algorithm as a flow chart. This figure details the action of the game manager in response to a point being touched.

Specification: I am surprised that the application does not contain an abstract, as the international application does contain an abstract. I attach the abstract.

Claim rejections - 35 USC 112: I cancelled claims 2-7.

Double Patenting: Once the behaviour of the board as described in lines 12-23 of claim 1 is taken into account, claim 1 is patentably distinct from US 6,568,683, and therefore there is no problem of double patenting.

Claim Rejections - 35 USC 102: Once the behaviour of the board as described in lines 12-23 of claim 1 is taken into account, Claim 1 is not anticipated by Golad US-6,231,441. I cancelled the other claims.

Claim Rejections - 35 USC 103: I cancelled claim 4.

Conclusion: It is not obvious to me if that require me to do anything about the prior art that I didn't mention.

Thanks,

Yehouda HARPAZ

